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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,464	03/16/2004	Debora Margaret Hejza Litwiller	A3557-US-NP	3203
75931 7590 06/11/2009 BASCH & NICKERSON LLP 1777 PENFIELD ROAD PENFIELD, NY 14526			EXAMINER PARKER, BRANDON	
			ART UNIT 2174	PAPER NUMBER
			NOTIFICATION DATE 06/11/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/801,464	<b>Applicant(s)</b> LITWILLER, DEBORA MARGARET HEJZA	
	<b>Examiner</b> BRANDON PARKER	<b>Art Unit</b> 2174	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

***Response to Arguments***

Applicant's arguments, see Remarks, filed 4/18/2008, with respect to the rejection(s) of claim(s) 1-20 under USC 102 (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of under 35 U.S.C. 103(a) as being unpatentable over Frederiksen et al (US Patent 6,859,287 Frederiksen hereinafter) in view of Marshall et al (US Publication 20030070139 Marshall hereinafter).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-15 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention *as a whole* must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement.

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Claim 7 discloses “a user interface for selecting and setting a variable value feature...”

The user interface itself merely software rather than a machine, manufacture, process or composition of matter. As such, it fails to fall within a statutory category. Therefore, claim 7 is rejected because the claimed invention is directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frederiksen et al (US Patent 6,859,287 Frederiksen hereinafter) in view of Marshall et al (US Publication 20030070139 Marshall hereinafter).

With respect to claim 1,

Frederiksen discloses a method of setting a variable value feature, having a plurality of values associated therewith wherein the plurality of values include a default value (Col. 2 lines 54 and 55) and a plurality of non-default values (Col. 3 lines 29-34), on a user interface, the user interface having user activatable areas (10, Fig. 1 Drawing) enabling a selection and changing (i.e. override) of the variable value (document size selector), (Col. 3 lines 15-18, Frederiksen Claim 14) feature

comprising: (a) displaying, on the user interface, a first numeric value (64 Fig. 1 Drawing) associated with a user selected variable value feature (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing). Note: The auto detect selection detects a size/numeric value.

(b) changing (i.e. override) the displayed first numeric value (64, Fig. 1 Drawing) associated with the selected variable value feature (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing) by a predetermined numeric amount (i.e. auto detect selection) so as to display a second numeric value (62 Fig. 1 Drawing) associated with the selected variable value feature by a user engaging (i.e. selecting/choosing) a user activatable area of the user interface (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing) associated with the selected variable value feature (i.e. choose a desired size, wherein the size represents a numeric value), (Col. 3 lines 15-39) .

(c) determining if an annotated message is associated with the displayed second numeric value (Ledger, 64 Fig. 1 Drawing) associated with the selected variable value feature (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing), the annotated message expressing information (i.e. ledger) equivalent to the displayed second numeric value (52, Fig. 1 Drawing) in a non-numeric form (letter, industry accepted standard value Col. 3 lines 55-62) Note: the annotated message "ledger" represents a size that is in non-numeric form (64, Fig. 1 Drawing).

(d) displaying the annotated message (Ledger, 64 Fig. 1 Drawing) associated (i.e. corresponding) with the selected variable value feature (Col. 3 lines 55-58) along with the displayed second numeric value (64 Fig. 1 Drawing) associated with the selected variable value feature (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing) when it is

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determined that the displayed second numeric value (62, 36 Fig. 1 Drawing) associated with the selected variable value feature feature (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing) has an associated annotation message (i.e. Ledger, 64, Fig. 1 Drawing), Note: Ledger is displayed when a ledger sized document is selected.

Frederiksen does not explicitly disclose (e) displaying no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message (Col. 3 lines 29-39). Note: It is understood by the examiner that displaying no annotated message means no annotated message is displayed when it is determined that the second numeric value has no associated annotated message. Frederiksen discloses two sections: a original section (28, Fig. 1 Drawing) wherein a letter size document can be selected (Col. 2 lines 60-62) wherein the annotated message "Letter" is shown (64, Fig. 1 Drawing) and a modify section (30 Fig. 1 Drawing) wherein the size of the block is displayed (Col. 3 lines 33 and 34) but does not appear to show an annotated message.

Marshall discloses to notice in the page shown in FIG. 3 is simply how heavily annotated the page is. There is little on the page that doesn't bear the reader's marks. This example also illustrates several stages of processing that must occur to detect the high-value annotations. First, the reader's marking style needs to be characterized. This allows the value of the annotations to be normalized. To normalize the value of the annotations, the frequency of the reader's marks within the context of the document and the page need to be determined and the types of marks the reader is prone to make should be identified. In particular, a determination should be made concerning whether

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the reader usually underlines, highlights, uses margin bars, writes symbols in the margin, and/or composes extensive marginalia. If a reader normally makes few marks on a document, any highlighted passage is likely to be high-value annotation.

Alternatively, if a reader uses a highlighter on most pages, any single instance of highlighting is not apt to be that important. Characterization of style allows weights to be assigned to individual annotations to assess the relative value of these annotations (Par. 0038).

It would have been obvious to one skilled in the art at the time of invention to combine the annotation determination as taught by Marshall with the facsimile numeric/image annotation of Frederiksen to effectively and efficiently display default values and non default values when selecting values.

With respect to claim 2,

Frederiksen discloses a method wherein the selected variable value feature is a magnification function (enlarged, decreased Col. 3 lines 34-39)

Claim 13 is similar in scope to claim 2 and is therefore rejected under similar rationale.

With respect to claim 3,

Frederiksen discloses a method wherein the selected variable value feature is a facsimile transmission function (Col. 3 lines 29-34)

Claim 14 is similar in scope to claim 3 and is therefore rejected under similar rationale.

With respect to claim 4,

Frederiksen discloses a method wherein the selected variable value feature is a contrast function (Col. 3 lines 34-39)

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Claim 15 is similar in scope to claim 4 and is therefore rejected under similar rationale.

With respect to claim 5,

Frederiksen discloses a method further comprising: (e) disabling the user activatable area of the user interface associated with the selected variable value feature for a predetermined period of time when it is determined that the displayed second numeric value associated with the selected variable value feature has an associated annotation message so as to allow the user to become aware of the displayed annotated message (Col 3 lines 34-39) Official notice is taken that in software application when a minimum and/or maximum value is reached the activatable area will be disabled causing the area to be inactive, since maximum and minimum values have no further boundaries.

Claim 9 and 17 are similar in scope to claim 5 and are therefore rejected under similar rationale.

With respect to claim 6,

Frederiksen discloses a method further comprising: (e) determining whether the displayed second numeric value (36, Fig. 1 Drawing) associated with the selected variable value feature is a minimum value for the selected variable value feature (54, 56 Fig. 1 Drawing); (f) disabling a user activatable area of the user interface associated selected variable value feature (54,56 Fig. 1 Drawing) that enables the value of the selected variable value feature (54,56 Fig. 1 Drawing) to be decremented when it is determined that the displayed second numeric value associated with the selected



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variable value feature is a minimum value for the selected variable value feature (i.e. decreased by depressing the reduce button), (Col. 3 lines 34-37); (g) determining whether the displayed second numeric value (36, Fig. 1 Drawing) associated with the selected variable value feature (54, 56 Fig. 1 Drawing) is a maximum value for the selected variable value feature (54, Fig. 1 Drawing); and (h) disabling a user activatable area of the user interface associated selected variable value feature that enables the value of the selected variable value feature to be incremented when it is determined that the displayed second numeric value associated with the selected variable value feature is a maximum value for the selected variable value feature (Col 3 lines 34-39).

Claim 12, 18, 19, and 20 are similar in scope to claim 6 and are therefore rejected under similar rationale.

With respect to claim 7,

Frederiksen discloses a user interface for selecting and setting a variable value feature, having a plurality of values associated therewith wherein the plurality of values include a default value and a plurality of non-default values, comprising:

a display area to display a first numeric value (Letter, 64 Fig. 1 Drawing) associated with a user selected variable value feature (54,56 Fig. 1 Drawing);

a user activatable area (Fig. 1 Drawing) to change (i.e. override) the displayed first numeric value (Letter 64, Fig. 1 Drawing) associated with the selected variable

value feature (54, 56 Fig. 1 Drawing) by a predetermined numeric amount (i.e. auto detect selection) so as to display a second numeric value (Ledger, 64 Fig. 1 Drawing) associated with the selected variable value feature (54, 56 Fig. 1 Drawing), (Col. 3 lines 9-19, 29-39);

a memory for storing a number of annotated messages, each annotated message (i.e. letter, 64 Fig. 1 Drawing) being associated (i.e. represents) a numeric value (i.e. size), (Col. 2 lines 60-63) of the user selected variable value feature (54, 56 Fig. 1 Drawing), the annotated message expressing information equivalent to the associated numeric value of the user selected variable value feature in a non-numeric form (Letter, 64, Fig. 1 Drawing); Note: "Letter" is displayed (i.e. non-numeric form) on the interface which represents the size (i.e. numeric value), (Col. 2 lines 60-63) and

a controller to determine if a stored annotated message is associated with the displayed second numeric value (Ledger, Fig. 1 Drawing) associated with the selected variable value feature (54, 56 Fig. 1 Drawing);

said controller causing said display area to display the annotated message (Ledger 64, Fig. 1 Drawing) associated with the selected variable value feature (54, 56 Fig. 1 Drawing) along with the displayed second numeric value (i.e. size, 64 Fig. 1 Drawing) associated with the selected variable value feature (54, 56 Fig. 1 Drawing) when it is determined the displayed second numeric value (Ledger 64, Fig. 1 Drawing) associated with the selected variable value feature (54, 56 Fig. 1 Drawing) has an

associated annotation message (Ledger 64, Fig. 1 Drawing); Note: Ledger is displayed on the interface which represents the size (i.e. numeric value).

Frederiksen does not explicitly disclose (e) displaying no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message (Col. 3 lines 29-39). Note: It is understood by the examiner that displaying no annotated message means no annotated message is displayed when it is determined that the second numeric value has no associated annotated message. Frederiksen discloses two sections: a original section (28, Fig. 1 Drawing) wherein a letter size document can be selected (Col. 2 lines 60-62) wherein the annotated message "Letter" is shown (64, Fig. 1 Drawing) and a modify section (30 Fig. 1 Drawing) wherein the size of the block is displayed (Col. 3 lines 33 and 34) but does not appear to show an annotated message.

Marshall discloses to notice in the page shown in FIG. 3 is simply how heavily annotated the page is. There is little on the page that doesn't bear the reader's marks. This example also illustrates several stages of processing that must occur to detect the high-value annotations. First, the reader's marking style needs to be characterized. This allows the value of the annotations to be normalized. To normalize the value of the annotations, the frequency of the reader's marks within the context of the document and the page need to be determined and the types of marks the reader is prone to make should be identified. In particular, a determination should be made concerning whether the reader usually underlines, highlights, uses margin bars, writes symbols in the margin, and/or composes extensive marginalia. If a reader normally makes few marks

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on a document, any highlighted passage is likely to be high-value annotation.

Alternatively, if a reader uses a highlighter on most pages, any single instance of highlighting is not apt to be that important. Characterization of style allows weights to be assigned to individual annotations to assess the relative value of these annotations (Par. 0038).

It would have been obvious to one skilled in the art at the time of invention to combine the annotation determination as taught by Marshall with the facsimile numeric/image annotation of Frederiksen to effectively and efficiently display default values and non default values when selecting values.

With respect to claim 8,

Frederiksen discloses a user interface wherein said user activatable area includes an up user activatable area to increment the displayed first numeric value associated with the selected variable value feature by a predetermined numeric amount (54/Fig. 1 Drawing) and a down user activatable area to decrement the displayed first numeric value associated with the selected variable value feature by a predetermined numeric amount (56/Fig. 1 Drawing)

With respect to claim 10,

Frederiksen discloses a user interface wherein said up user activatable area is a first push button (54/Fig. 1 Drawing) and said down user activatable area is a second push button (56/Fig. 1 Drawing)

With respect to claim 11,

Frederiksen discloses a user interface as claimed in claim 8, wherein said up user activatable area (54/Fig. 1 Drawing) is a first area on a touch screen and said down user activatable area (56/Fig. 1 Drawing) is a second area on a touch screen (touch screen/graphical icon system 10 Fig 1. Drawing).

Regarding claim 16,

Frederiksen discloses a method of setting a variable value feature, having a plurality of values associated therewith wherein the plurality of values include a default value and a plurality of non-default values (Col. 2 lines 54 and 55), on a user interface, the user interface having user activatable areas (10/Fig. 1) enabling a selection and changing of the variable value feature (document size selector), (Col. 3 lines 15-18, Frederiksen Claim 14) comprising: (a) displaying, on the user interface, a first numeric value (64 Fig. 1 Drawing) associated with a user selected variable value feature (auto-detect selection/default value, first numeric value Col. 3 lines 9-19), (10 Fig. 1 Drawing)

(b) changing (i.e. override) the displayed first numeric value (64, Fig. 1 Drawing) associated with the selected variable value (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing) feature by a predetermined numeric amount (i.e. auto detect selection) so as to display a second numeric value (62 Fig. 1 Drawing) associated with the selected variable value feature by a user engaging (i.e. selecting/choosing) a user activatable area of the user interface (Col. 3 lines 9-19, 54/56 Fig. 1 Drawing) associated with the selected variable value feature (override/changing Col. 3 lines 15-39)

(c) determining if the displayed second numeric value is an industry accepted standard value associated with the displayed second numeric value (letter, industry accepted standard value Col. 3 lines 55-62) and

(d) displaying an annotated corresponding to the industry accepted standard value along with the displayed second numeric value associated with the selected variable value feature when it is determined that the displayed second numeric value is an industry accepted standard value associated with the selected variable value feature, the annotated message expressing the industry accepted standard value associated with the displayed second numeric value in a non-numeric form (Letter, 64 Fig. 1 Drawing); Note: the annotated message “ledger” represents a size (i.e. numeric/industry accepted value) that is in non-numeric form (64, Fig. 1 Drawing) and

Frederiksen does not explicitly disclose (e) displaying no annotated message when it is determined that the displayed second numeric value associated with the selected variable value feature has no associated annotation message (Col. 3 lines 29-39). Note: It is understood by the examiner that displaying no annotated message means no annotated message is displayed when it is determined that the second numeric value has no associated annotated message. Frederiksen discloses two sections: a original section (28, Fig. 1 Drawing) wherein a letter size document can be selected (Col. 2 lines 60-62) wherein the annotated message “Letter” is shown (64, Fig. 1 Drawing) and a modify section (30 Fig. 1 Drawing) wherein the size of the block is displayed (Col. 3 lines 33 and 34) but does not appear to show an annotated message.

Marshall discloses to notice in the page shown in FIG. 3 is simply how heavily annotated the page is. There is little on the page that doesn't bear the reader's marks. This example also illustrates several stages of processing that must occur to detect the high-value annotations. First, the reader's marking style needs to be characterized. This allows the value of the annotations to be normalized. To normalize the value of the annotations, the frequency of the reader's marks within the context of the document and the page need to be determined and the types of marks the reader is prone to make should be identified. In particular, a determination should be made concerning whether the reader usually underlines, highlights, uses margin bars, writes symbols in the margin, and/or composes extensive marginalia. If a reader normally makes few marks on a document, any highlighted passage is likely to be high-value annotation. Alternatively, if a reader uses a highlighter on most pages, any single instance of highlighting is not apt to be that important. Characterization of style allows weights to be assigned to individual annotations to assess the relative value of these annotations (Par. 0038).

It would have been obvious to one skilled in the art at the time of invention to combine the annotation determination as taught by Marshall with the facsimile numeric/image annotation of Frederiksen to effectively and efficiently display default values and non default values when selecting values.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON PARKER whose telephone number is (571)270-1302. The examiner can normally be reached on Monday thru Friday 730- 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on 571-272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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